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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------------|------------------|
| 08/881,096 | 06/24/1997 | GREGORY J. SPEICHER | 935-008 | 2718 |
| 7590 07/19/2004 WARD & OLIVO 708 THIRD AVENUE NEW YORK, NY 10017 | | | EXAMINER CHAMPAGNE, DONALD | |
| | | | ART UNIT 3622 | PAPER NUMBER |

DATE MAILED: 07/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/881,096

Applicant(s)

SPEICHER, GREGORY J.

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 51-87 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 51-87 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 June 1997 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed with an amendment on 7 April 2004 have been fully considered but they are moot in view of the new basis of rejection.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 51-55 and 83 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

At claim 51 line 7, "establishing a second communication" is indefinite because there is no limitation to establishing a first communication.

At claim 83 line 2, "said second Internet Web page" lacks antecedent basis.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 USC 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 51-87 are rejected under 35 USC 103(a) as obvious over Hyodo in view of Norris et al. and Rondeau.
6. Hyodo teaches (independent claims 51, 56, 61, 66, 72 and 79) a method for providing an enhanced computer-based advertising system, comprising: an advertiser placing an advertisement and inputting a telephone number, storing said advertisement and said telephone number in a database and publishing the advertisement via the Internet (col. 3 lines 13-15 and col. 4 lines 12-19).

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7. Hyodo does not teach determining if said advertiser is available to receive a real-time Internet communication. Norris et al. teaches (abstract) Internet call waiting, which reads on determining if said advertiser is available to receive a real-time Internet communication. Because advertisers do not want to loose customers to a busy signal, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Norris et al. to those of Hyodo.
8. Hyodo does not teach establishing said real-time Internet communication between a user and said advertiser. Rondeau teaches (col. 3 lines 3-10) establishing said real-time Internet communication between a user and said advertiser. Because facilitating users to talk to advertisers would enhance the Hyodo service, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Rondeau to those of Hyodo.
9. The references do not teach (claim 56) a second user. Because the reference invention is clearly applicable to any number of users, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add a second user to the teachings of Hyodo, Norris et al. and Rondeau. Rondeau teaches (col. 5 line 12) communication with said user via a PC (also claims 74 and 82).
10. Rondeau also teaches at the citation given above VoIP initiated from a web page (claims 61 and 52, 57, 62, 68, 75, 83 and 84).
11. The references do not teach (claims 53, 58, 63, 69, 76 and 85) maintaining anonymity of the advertiser. Because this is a well-known property of personals ads, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add anonymity of the advertiser to the teachings of Hyodo, Norris et al. and Rondeau.
12. Hyodo also teaches (claims 54-55, 59-60, 64-65, 70-71, 77-78 and 86-87): the toll free number (col. 2 lines 34-35), which reads on text advertising, and telephoning the toll-free number (col. 2 lines 39-40), which reads on audio advertising; and charging the advertiser (col. 4 lines 50-55).
13. The references do not teach (claims 73 and 81) that the two Internet web pages are the same. Because revenue could be increased by offering both advertising and VoIP service at a single website, it would have been obvious to one of ordinary skill in the art, at the time

of the invention, to add that the two Internet web pages are the same to the teachings of Hyodo, Norris et al. and Rondeau.

Conclusion

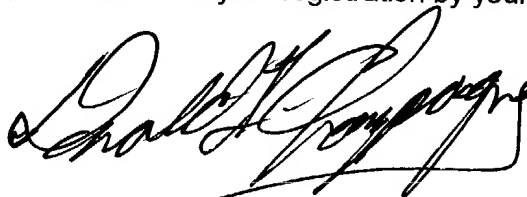
14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
15. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 703-308-3331. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 703-746-5536.
17. The examiner's supervisor, Eric Stamber, can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5771.
18. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that "disposal or clarification for appeal may be accomplished with only nominal further consideration" (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words.

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Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.

19. Applicant may have after final arguments considered and amendments entered by filing an RCE as appropriate.

20. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.



Donald L. Champagne
Primary Examiner
Art Unit 3622

11 July 2004